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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,350	11/03/2003	Joanne Sheehan	102767-0028a	5358

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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,350

Applicant(s)

SHEEHAN, JOANNE

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action acknowledges the applicant's Response submitted 10 February 2005. Claims 1-19 are pending in the application. Claims 20-29 have been canceled.

2. Applicant's election of Group I in the reply filed on 10 February 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Drawings

3. The drawings filed 20 May 2004 are objected to because:

Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications (see 37 CFR 1.84(b)). The subject matter admits of illustration; therefore, examiner herein requires drawings in place of the photographs.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

Art Unit: 3728

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 13, it is unclear as to whether the "parts" for the phases in the process are being claimed. The applicant uses the terminology "kit" yet only mentions the cavities "corresponding to" the parts. To prosecute the claims on their merits, the examiner assumes that only the templates are being claimed.

Claims 2-12 and 14-19 are dependent on claims 1 and 13 and are rejected for the above reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6-10, and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (US 3,191,791).

Regarding claim 1, inasmuch as the examiner can determine the scope of claim and assuming the parts are not positively recited, Jackson discloses a first template **11** with a plurality of cavities **19**, and a further template **12** with a plurality of cavities **19** arranged in a sequence (see Figure 1). Jackson is capable of retaining parts and functioning as claimed.

Claims 2, 3, and 9 are intended use claims. Jackson is capable of being used in the claimed manner.

As to claim 4, Jackson discloses foam (Col. 3, lines 36-37).

As to claims 6, 7, and 8, Jackson discloses supports **16** and **17**.

As to claim 10, Jackson is stacked (see Figure 1).

Regarding claim 13, Jackson anticipates more than two templates (Col. 2, lines 60-63) and therefore anticipates three templates. Inasmuch as the examiner can determine the scope of claim and assuming the parts are not positively recited, Jackson, as applied to claim 1 above is capable of retaining a small rectangular

Art Unit: 3728

computer chassis, a small rectangular CPU base, and a small rectangular chassis cover.

Claims 14, 15, and 19 are intended use claims. Jackson is capable of being used in the claimed manner.

As to claim 16, Jackson discloses foam (Col. 3, lines 36-37).

As to claims 17 and 18, Jackson discloses supports **17**.

6. Claims 1, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Olson (US 6,056,121).

Regarding claim 1, inasmuch as the examiner can determine the scope of claim and assuming the parts are not positively recited, Olson discloses a first template **74** with a plurality of cavities **80**, and a further template **76** with a plurality of cavities **82** arranged in a sequence (see Figure 2). Olson is capable of retaining parts and functioning as claimed.

As to claims 11, Olson discloses box **54** and cover **56**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3728

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson in view of Berbeco (US 4,231,901).

Jackson merely lacks the express disclosure of electrically conductive foam.

Berbeco discloses that electrically conductive foam was a desirable material to prevent accumulation of static charge. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Jackson in electrically conductive foam in order to prevent accumulation of static charge. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Grasty et al discloses kit trays with cavities and stacked in a particular phase sequence. Tu, Tatsuura et al, and Secrest, Jr. disclose kit trays. Ahlsen et al, Terabayashi et al, and Kenik et al disclose flexible assembly systems


Art Unit: 3728


using kit trays. Brown and Goss disclose computer assembly using kit trays. Smith et al discloses a means to form kit trays for use in a flexible assembly process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
29 April 2005


Mickey Yu
Supervisory Patent Examiner
Group 3700